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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/002,104      | 12/05/2001  | Joseph Ho            | MR2349-74i          | 2168             |

4586 7590 02/02/2004

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| EXAMINER |
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POKER, JENNIFER A

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| ART UNIT | PAPER NUMBER |
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2832

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/002,104

Applicant(s)

HO, JOSEPH

Examiner

Jennifer A. Poker

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3, 5, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 5, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on December 5, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 13, 2003 has been entered.

### *General Status*

2. This is a first action (subsequent to filing of RCE) on the merits of application filed on December 5, 2001. Claims 3, 5, 7, and 8 are pending and are being examined.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,118,363 to Chanteau, et al, in view of U.S. Patent Number 3,851,290 to Stover, et al.

Regarding claims 7 and 8, Chanteau, et al, discloses a present invention relates to a self-inductance element for flowing through an AC current, the element comprising:

- (1) a rectilinear magnetic core (figure 1; column 1, lines 5-6, 31-32);

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(2) a coil winding, helically wound on the magnetic core, (figure 1);

Chanteau, et al, discloses the claimed invention except for the fusible winding.

Stover, et al, discloses a fuse, and particularly a fuse, which has a link, which quickly electrically opens, when the rated AC or DC current of the fuse is exceeded. The fuse comprises an electrical conducting wire, which serves as a fusible link and which is connected between two terminals and immersed in a high dielectric strength liquid.

One skilled in the art, at the time the invention was made, would have found it obvious to combine the teachings of Chanteau, et al, with the teachings of Stover, et al, and utilize a fusible winding about the magnetic core for the purposes of excellent electrical conductivity characteristics and a high temperature electrical insulation. The fusible wire is used in an electric circuitry comprising a conductor for opening the circuit in response to a given current level. Because applicant appears to use the terms fusible/resistance interchangeably, it was understood that the fusible winding disclosed by Stover, et al, would also function as a resistance winding.

Chanteau, et al, in view of Stover, et al, discloses the claimed invention except for the intended use of the fusible material causing an open circuit upon the flow of current FOR limiting current flow to levels below a predetermined electrical current. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*. Furthermore, the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

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Regarding claim 3, Stover, et al, further discloses a high dielectric strength liquid surrounding the wire. The motivation for utilizing dielectric liquid would have been to insulate the fusible winding.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,118,363 to Chanteau, et al, in view of U.S. Patent Number 3,851,290 to Stover, et al, as applied to claim 7 above, and further in view of U.S. Patent Number 4,641,115 to Bailey.

Chanteau, et al, in view of Stover, et al, disclose the claimed invention except for the use of 2 windings.

Bailey discloses choke coils having two windings wherein a primary winding is wound onto the core and a secondary coil is wound atop of the secondary winding for the purposes of dampening parasitic capacitances, (abstract)(Figure 5)

One skilled in the art, at the time the invention was made, would have found it obvious to combine the teachings of Chanteau, et al, with the teachings of Stover, et al, and include a secondary winding about the first fusible winding in order to dampen parasitic capacitances.

### ***Response to Arguments***

6. Applicant's arguments filed November 13, 2003 have been fully considered but they are not persuasive.

7. Regarding independent claim 7, applicant asserts that no prior art of record teaches a coil constructed of fusible material "for limiting current flow to levels below a certain electrical current." A recitation of the intended use of the claimed invention must result in a structural difference

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between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). And, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In response to applicant's argument that the Baily and Stover references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Stover reference teaches a fusible winding, and the Baily reference teaches additional windings for the purposes of dampening parasitic capacitances.

Additional arguments are addressed below:

- (1) Disapproval of the drawings is hereby withdrawn.
- (2) Objection to the specification (abstract) is hereby withdrawn.
- (3) Objection under 35 U.S.C. 132 to the amendment filed March 21, 2003 is hereby withdrawn.

### ***Contact Information***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Poker whose telephone number is 703-305-4037. The examiner can normally be reached on 5:30-4:00 Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin G. Enad can be reached on 703-308-7619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

Jap  
January 12, 2004

  
ELVIN ENAD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER  
01/29/04